

Application No: 10/868,876
Attorney Docket No. 82410.0087/0B-045000US
Amendment of November 14, 2006

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Remarks

Applicant respectfully requests consideration of the remarks below, which Applicant submits places the application in condition for allowance.

Rejection of Claims 15, 17-23, 25-27, 29 and 30 Under 35 U.S.C. § 102(b)

Claims 15, 17-23, 25-27 and 30 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,218,045 ("Black").

Applicant respectfully submits that Black does not disclose, explicitly or inherently, each limitation claimed in independent claim 15 (and accordingly in claims 17-23, 25-27, 29 and 30).¹ For example, Applicant's claims presently recite the limitation of an "arbitrarily-shaped electrode overmolded by a portion of the catheter." The invention as presently claimed allows for, *inter alia*, selective removal of the overmold to yield any desired combination or configuration of, e.g. arbitrarily-shaped, electrodes.

Black does not fairly teach, nor suggest for that matter, an "arbitrarily-shaped electrode overmolded by a portion of the catheter." To the contrary, Black discloses only conventional ring electrodes, specifically defined and configured utilizing electrode spacers 28 and terminal spacers 30, to "accurately define[] a space between the adjacent electrodes and terminals respectively." See e.g., Black at 6:20-24 (emphasis added); Fig. 5. The overmold surface in Black is then removed, via "a grinding process to remove all excess material" to expose this "accurately defined" electrode structure. See Black at 7:5-

¹ Applicant submits that dependent claims 17-23, 25-27, 29 and 30 also contain further limitations that render these claims patentable for reasons in addition to independent claim 15. Applicant reserves the right to present such arguments, should they be deemed necessary, and expressly states that the currently rejected claims do not stand or fall with independent 15.

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34 (emphasis added). The resulting structure in Black is thus a unitized lead in which all of the specifically defined, conventional electrode structure is exposed. To the extent Black discloses any overmolded portion, it is described only as an "intermediate" step in the method, that is subsequently removed through grinding to expose all of the specifically defined electrode structure.

Black does not, therefore, teach the limitation of an arbitrarily-shaped electrode overmolded by a portion of the catheter. Indeed, Applicant respectfully submits that Black's explicit teaching of removing all the excess overmold material from the electrode structure actually teaches away from the presently claimed invention. The purpose of Black's method of manufacture is to yield a unitized, substantially isodiametric lead (see e.g., Black at 2:28-46), not to provide the claimed "arbitrarily-shaped electrode overmolded by a portion of the catheter" as included in all of the claims of the present application. Indeed, Black discloses removal of even a portion of the electrode itself to achieve this isodiametric property. Black at 7:26-29.

For these reasons, Applicant respectfully submits that the Examiner's rejection of claims 15, 17-23, 25-27 and 30 be withdrawn.

Rejection of Claims 16, 24 and 28 Under 35 U.S.C. § 103(a)

Dependent claims 16 and 28 stand rejected as allegedly being obvious over Black. Specifically the Examiner contends that the additional limitations of: "electrodepositing a biocompatible material within a depression formed on the catheter tip" in claim 16; and "wherein the trace is electro-deposited on an exterior portion of the catheter body" in claim 27 are obvious matters of design choice. Claims 16 and 28 are dependent upon claim 15.

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Thus, while Applicant respectfully disagrees with the Examiner's rejection in this regard, Applicant submits that claims 16 and 28 are patentable for the same reasons as discussed with respect to the Examiner's anticipation rejection of claim 15 above – namely that Black does not fairly teach or suggest the limitation of an "arbitrarily-shaped electrode overmolded by a portion of the catheter." Applicant therefore submits the rejection of claims 16 and 28 as obvious over Black be withdrawn.

Dependent claim 24 stands rejected as allegedly being obvious over Black in view of U.S. Patent No. 5,125,913 ("Quackenbush"). Claim 24 is a dependent claim, ultimately depending from independent claim 15. Again, while Applicant respectfully disagrees with the Examiner's rejection in this regard, Applicant submits that claim 24 is patentable for the same reasons as discussed with respect to the Examiner's anticipation rejection of claim 15 above – namely that Black does not fairly teach or suggest the limitation of an "arbitrarily-shaped electrode overmolded by a portion of the catheter." Applicant therefore submits the rejection of claims 16 and 28 as obvious over Black in view of Quackenbush be withdrawn.

In view of the foregoing remarks, Applicant respectfully submits the application is now in condition for allowance and respectfully requests a prompt issuance of a Notice of Allowance. This Response is being submitted with a request and the appropriate fee for a three-month extension of time.

No other petitions, additional claim fees, or any other additional fees are believed to be necessary to enter and consider this paper. If, however, any extensions of time are required or any fees are due in order to enter or consider this paper or enter or consider any paper accompanying this paper, including fees for net addition of claims, Applicant hereby requests any extensions or petitions necessary and the Commissioner is hereby


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authorized to charge our Deposit Account No. 50-1129 for any fees. If there is any variance between the fee submitted and any fee required, or if the payment or fee payment information has been misplaced or is somehow insufficient to provide payment, the Commissioner is hereby authorized to charge or credit Deposit Account No. 50-1129.

Respectfully submitted,

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